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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,394	02/15/2001	Marc Eller	12179-P081P1	2998

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/15/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,394

Applicant(s)

ELLER ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5,6 and 14-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/16/03 have been fully considered but they are not persuasive.

Applicant argues that the instant application claims priority to provisional applications 60/147,673 and 60/130,602. After review of the provisional applications, the examiner found no support for independent claims 14 and 19, specifically the limitations "selecting, via the third information handling system, which of the first and second electronic billboards will display the information". The provisional applications refer to an ebillboard.net server 402 for controlling what is displayed on www.billboard401.com and only controlling one billboard 401 (information handling system). Both specifications in the provisional application fail to support a first and a second information handling system coupled to a third information handling system. As disclosed in the instant application in Figure 3, there resides a Billboard Provider (third information handling system), for approving created ads from a first and second information handling system. The provisional applications also do not disclose a "digital television broadcast network".

Therefore, the rejection of claims 5-6 and 14-20 stand.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14 and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Carney et al. (U.S. Patent No. 6,408,278).

Referring to claim 14, Carney discloses providing a first electronic billboard at a first location (see element 14a in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a first information handling system to the first electronic billboard (see element 24a in Figure 3) so that the first information handling system can control information to be displayed on the first electronic billboard (Column 3, Lines 57-67).

Carney also discloses providing a second electronic billboard at a second location (see element 14n in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a second information handling system to the second electronic billboard (see element 24n in Figure 3) so that the second information handling system can control information to be displayed on the second electronic billboard (Column 3, Lines 57-67).

Carney also discloses coupling the first and second information handling systems to a third information handling system over a digital television network (see element 20 in Figure 3 and Column 3, Line 6).

Carney also discloses selecting, via the third information handling system, which of the first and second electronic billboards will display the information (Column 3, Lines 55-67).

Carney also discloses uploading the information from the third information handling system (Column 3, Lines 59-63) over the Internet (Column 5, Lines 40-42) to the information handling system controlling the selected electronic billboard (Column 5, Lines 37-40).

Carney also discloses displaying the information on the selected electronic billboard (Column 3, Lines 65-67 and Column 5, Lines 26-29).

Referring to claim 19, see rejection of claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney et al. in view of Hunter (U.S. Patent No. 6,430,605).

Referring to claim 15, Carney teaches all of the limitation in claim 14, but fails to teach a time period for displaying information on the billboard and displaying the information for the specified time period.

Hunter teaches selecting advertisements on a billboard at a selected time period (Column 8, Lines 57-67), and displaying an advertisements for the selected period of time (Column 9, Lines 15-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the server 20 (third information handling system), as taught by Carney, using the option to specific a time period for displaying programming content, as taught by Hunter, for the purpose of alerting the users of "sale" items that are only available for a specified limited time (Column 2, Lines 47-52 of Hunter).

Referring to claim 16, Carney teaches all of the limitations in claim 14, but fails to teach the additional limitation of choosing the first and second billboard to receive information from a list of billboards.

Hunter teaches selecting which roadway-adjacent billboards to display programming content (Column 8, Lines 63-67).

At the time the invention was made, it would have been obvious to modify the server 20, as taught by Carney, using the option to allow the advertiser to choose which billboard to displaying information from a list, as taught by Hunter, for the purpose of allowing an advertise to only choose to display programming content where a high traffic volume is known (Column 2, Lines 25-30 of Hunter).

Claim 17 corresponds to claim 16, with the additional limitation of the list including a map of the first and second locations. Hunter teaches that a map can provide the location and directions to a company's local stores (Column 9, Lines 2-5).

Claim 18 corresponds to claim 16, with the additional limitation of charging an amount of money for the display of the information on the selected electronic billboard. Hunter teaches a module 190 for producing bills for charging an advertiser (Column 5, Lines 32-34).

Referring to claim 20, see rejection of claim 15.

Referring to claim 5, Carney and Hunter teach all of the limitations in claim 14, but fail to teach a television transmitter for transmitting the billboard information to the billboard in a wireless manner. The examiner notes that it is well known in the art to broadcast billboard information over a television network. The examiner takes Official Notice that it would have been obvious to modify the billboard system of Carney and Hunter to utilize a television broadcast network, for the purpose of providing billboard information in a more efficient manner.

Claim 6 corresponds to claim 5, with the additional limitation of providing a multiplexer. The examiner notes that a multiplexer is also well known in a television network, and it would have been obvious to use a multiplexer for the purpose of providing the television signals in a compact and universal format for decoding purposes.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5359 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

August 4, 2003


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600